



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

R. CHANEY et al.

Art Unit: 1638

Application Number: 09/437,607

Examiner: M. Ibrahim

Filed: November 10, 1999

Attorney Dkt. No.: 108172-00037

For: RECOVERING METALS FROM SOIL

SUBMISSION OF TERMINAL DISCLAIMER

RECEIVED

Commissioner for Patents
Washington, D. C. 20231

MAR 06 2003

March 3, 2003

Sir:

TECH CENTER 1600/2900

Submitted herewith for filing in the above-identified application, is a Terminal

Disclaimer.

The Commissioner is hereby authorized to the charge the necessary fee of One Hundred Ten Dollars (\$110.00) along with any additional fees which may be due with respect to the filing of this paper to Deposit Account Number 01-2300, referencing Attorney Docket No. 108172-00037.

Respectfully submitted,
AREN FOX KINTNER PLOTKIN & KAHN PLLC

By: 

Hans J. Crosby
Attorney for Applicants
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HJC/ccd
Enclosure: Terminal Disclaimer (2)

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Applicants submit the enclosed Terminal Disclaimer to overcome this rejection. Therefore, Applicants request that the double patenting rejection be removed from abeyance given the present submission of the Terminal Disclaimer, and that the double-patenting rejection be withdrawn.

Applicants respectfully submit that this application is in condition for allowance and request favorable action thereon.

In the event this paper is not timely filed, applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300, referring to client-matter number 108172-00037, along with any other additional fees which may be required with respect to this paper.

Respectfully submitted,

ARENT FOX KINTNER PLOTKIN & KAHN, PLLC



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Enclosures: Submission of Terminal Disclaimer; Terminal Disclaimer (2)

SUBJECT: DECISION ON TERMINAL DISCLAIMERS INFORMAL FORM

DATE: 7/15/03

APPL. S.N.: 1

TO EXAMINER: 1/brodim

ART UNIT: 1638

ROOM

MAILROOM DATE 9/3/03

AFTER FINAL YES NO X NUMBER OF T.D(S). FILED 1

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next office action to notify applicant about the T.D. If you disagree with my analysis or have questions at all about the acceptability of the T.D., please see me or our Special Program Examiner. THIS MEMO IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE MAILED TO APPLICANT, NOR SHOULD A COPY BE LEFT IN FILE.

☒ The T.D. is PROPER and has been recorded. (See 14.23).

☐ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below. (See 14.24).

☐ The recording fee of \$_____ has not been submitted nor is there any pre authorization in the application file to charge to a deposit account. (See 14.26.07)

☐ Application Examiner has not processed T.D. fee. (See fee authorization).

☐ The T.D. does not satisfy Rule 321(b)(3) in that the person who has signed the T.D. has not stated his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent. (See 14.26 and 14.26.01).

☐ The T.D. lacks the enforceable only during the common ownership clause needed to overcome a double patenting rejection, Rule 321(c). (See 14.27, 14.27.01).

☐ It is directed to a particular claim(s), which is not acceptable since "the disclaimer must be of a terminal portion of the term of the entire patent to be granted". MPEP 1490. (See 14.26, 14.26.02).

☐ The person who signed the terminal disclaimer:

☐ has failed to state his/her capacity to sign for the business entity. (See 14.28).

☐ is not recognized as an officer of the assignee. (See 14.29 and possibly 14.29.01).

☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame specified as to where such evidence is recorded in the office. 37 CFR 3.73(b). (See 1140 O.G. 72). **NOTE:** This documentary evidence or the specifying of the reel and frame may be found in the T.D. or in a separate paper submitted by applicant. (See 14.30).

☐ No "statement" specifying that the evidentiary documents have been reviewed and that, to the best of the assignee's knowledge and belief the title is in the assignee seeking to take action. 37 CFR 3.73(b). (See 1140 O.G. 72) (See 14.31).

☐ The T.D. is not signed. (See 14.26, 14.26.3), or 14.26.03 if TD is not signed by all the owners.

☐ Attorney not of record in oath/decl or a separate paper filed appointing a new or associate attorney. (See 14.29.01).

☐ The serial number of the application (or the number of the patent) which forms the basis for the double patenting is missing or incorrect. (See 14.32).

☐ The serial number of this application (or the number of the patent in reexam or reissue case(s) being disclaimed is missing or incorrect. (See 14.26, 14.26.04 or 14.26.05).

☐ The period disclaimed is incorrect or not specified. (See 14.27, 14.27.2 or 14.27.3) (For Samples 14.27.04 and 14.27.05)

☐ Other: _____

☐ Suggestion to request refund of \$_____. (See 14.35, 14.36).

EXAMINER NOTE: IF APPLICATION IS IN CONDITION FOR ALLOWANCE ANY OF THE ABOVE INFORMALTIES MAY BE FAXED IN TO THE GROUP

FOR SAMPLE TERMINAL DISCLAIMERS AND CERTIFICATES:

☐ Sample of a TD over a pending application and assignee Certificate (See 14.37).

☐ Sample of a TD over a prior patent and assignee Certificate (See 14.38).

☐ Sample Assignee Certificate under 37 CFR 3.73 (b) (See 14.39)



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Atty. Docket No. 108172-00037

Serial No.: 09/437,607

Group Art Unit: 1638

Filed: November 10, 1999

Examiner: M. Ibrahim

For: RECOVERING METALS FROM SOIL

TERMINAL DISCLAIMER UNDER 37 CFR 1.321(b)

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Commissioner of Patents
Washington, D. C. 20231

MAR 06 2003

Sir:

TECH CENTER 1600/2900

Petitioners, **UNIVERSITY OF MARYLAND**, College Park, MD, **THE UNITED STATES OF AMERICA AS REPRESENTED BY THE SECRETARY OF AGRICULTURE**, Washington, DC, and **UNIVERSITY OF SHEFFIELD**, Sheffield, United Kingdom, represent that they are jointly the assignee of all right, title and interest in and to the above-identified U. S. Patent Application. Petitioners are also the joint assignee of all right, title, and interest in and to U. S. Patent No. 5,944,872, issued August 31, 1999.

Petitioner hereby disclaims the terminal part, if any, of any patent granted on application Serial No. 09/437,607, which would extend beyond the expiration date of United States Patent No. 5,944,872, and hereby agrees that any patent so granted on application Serial No. 09/437,607, shall be enforceable only during such period that the legal title to such patent shall be the same as the legal title to United States Patent No. 5,944,872. this agreement to run with any patent

granted on the application, Serial No. 09/437,607, and to be binding on its grantee, its successors, or assigns.

Petitioner does not disclaim any terminal part of any patent granted on the above-identified application prior to the expiration date of the full statutory term as presently shortened by any terminal disclaimer of U.S. Patent No. 5,944,872 in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. 1.321(a), has all claims cancelled by a reexamination certificate, or is otherwise terminated prior to the expiration of its statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

Each of the undersigned on behalf of petitioners. **UNIVERSITY OF MARYLAND**, College Park, MD, **THE UNITED STATES OF AMERICA AS REPRESENTED BY THE SECRETARY OF AGRICULTURE**, Washington, DC, and **UNIVERSITY OF SHEFFIELD**, Sheffield, United Kingdom, hereby states and declares: I have the authority to execute this Terminal Disclaimer on behalf of the petitioner under which my signature is affixed.

Each of the undersigned hereby declares: All statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United

States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

UNIVERSITY OF MARYLAND

By: James C. Pailles

Title: Executive Director

Date: Feb 14, 2003

THE UNITED STATES OF AMERICA
AS REPRESENTED BY THE
SECRETARY OF AGRICULTURE

By: _____

Title: _____

Date: _____

UNIVERSITY OF SHEFFIELD

By: Dr. David Winstanley

Title: _____

Date: 13th Feb 2003

DR DAVID WINSTANLEY

INTELLECTUAL PROPERTY MANAGER
THE UNIVERSITY OF SHEFFIELD

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